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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/024,351

Applicant(s)

RUBINSTENN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claim 26 has been amended. Claims 1-30 are currently pending in the application.

Claim Objection has been withdrawn due to the applicant's amendment.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 and 24-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process

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was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, the claimed beauty diagnostic method does not recite a limitation in the technological arts. The claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever.

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The independently claimed steps of: "Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject; receiving answers to the personal questions; based on the received answers, selecting a customized set of testing material; and informing the subject about said customized set of testing material" are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: "selecting a customized set of testing material" may be understood as merely obtaining an advise from a beauty consultant in a beauty store. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-25 and 28-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Maloney et al. (WO 01/18674 A2).**

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising:

**Claim 1.** Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30); receiving answers to the personal questions (page 11,

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lines 26-27); based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (page 11, lines 7-9); informing the subject about said at least one customized set of testing material (page 11, lines 13-14).

**Claim 2.** Providing the subject with the customized set of testing material (page 11, lines 13-14).

**Claim 3.** See claim 2.

**Claim 4.** Ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20).

**Claim 5.** Recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

**Claim 6.** Said method and system, wherein the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator (page 11, lines 11-12).

**Claim 7.** Said method and system, wherein the questions are posed to the subject over a computer network (page 8, line 35 – page 9, line 2), and wherein the at least one customized set of testing material is delivered to the subject via a courier (column 11, line 18).

**Claim 8.** Maintaining an inventory of a plurality of different groups of customized sets of testing material (page 10, lines 4-5).

**Claim 9.** See claim 2.

**Claim 10.** See claim 2.

**Claim 11.** See claim 1.

**Claim 12.** See claim 2.

**Claim 13.** See claim 4.

**Claim 14.** See claim 5.

**Claim 15.** See claim 6.

**Claim 16.** See claim 7.

**Claim 17.** See claim 8.

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**Claim 18. See claim 9.**

**Claim 19. See claim 10.**

**Claim 20. See claim 1.**

**Claim 21. See claim 2.**

**Claim 22. See claim 4.**

**Claim 23. See claim 5.**

**Claim 24.** Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (page 11, lines 26-30); receiving answers to the personal questions (page 11, lines 26-27); based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (page 11, lines 7-9); providing the subject with the customized set of testing material (page 11, lines 13-14); ascertaining quantitative information by collecting data derived from use of the testing material on the subject (page 11, lines 15-16, 19-20); recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information (page 12, lines 27-33).

**Claim 25. See claim 1.**

**Claim 28. See claim 16.**

**Claim 29. See claim 2.**

**Claim 30. See claim 6.**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of in view of Rigg (US 6,293,284).**



As per **claims 26 and 27**, Maloney teaches all the limitations of **claims 26 and 27**, except specifically teaching that said information is an image of the external body condition.

Rigg teaches virtual makeover method and system, wherein a picture of the consumer is transmitted to a consultant at a remote location, and wherein said consultant can then provide further customized product-related information to said consumer (column 2, line 49 - column 3, line 7)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said information is an image of the external body condition, because the digital scan would provide the most accurate determination of natural skin color, thereby resulting in consultant's best recommendations.

### ***Response to Arguments***

Applicant's arguments filed 3/12/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that the inventive method steps produce useful, concrete and tangible results, the examiner maintains that the claimed invention is not within the technological arts. The independently claimed steps of: "Asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject; receiving answers to the personal questions; based on the received answers, selecting a customized set of testing material; and informing the subject about said customized set of testing material" are abstract ideas which can be performed mentally without interaction of a physical structure. Therefore, claims 1-10 and 24-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter (See discussion above).

In response to the applicant's argument that Maloney does not teach *based on ...received answers..., selecting from a plurality of testing materials ...a customized set of testing materials*, the examiner points out that Maloney explicitly disclose this feature. Specifically, on page 11, lines 7-9 Maloney teaches: "the collection of profiling data about a consumer comprises providing the consumer a test kit".

In response to the applicant's argument that Rigg does not teach *based on ...received answers..., selecting from a plurality of testing materials ...a customized set of testing materials*, it is noted that Rigg was applied to show providing customized product-related information to a consumer based on a picture of the consumer (Rigg C. 2, L. 49 – C. 3, L. 7).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, both Maloney and Rigg relate to a method and system for providing over a network personalized beauty-related information to a consumer based on consumer information. The system, disclosed in Maloney would benefit from Rigg by supplying a consultant with a digital image of the consumer, thereby providing the consultant with most accurate representation of natural skin color, which results in consultant's best recommendations.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiner suggests the Applicant review these documents before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 305-7687**

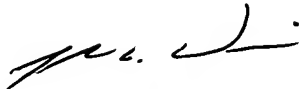
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Hand delivered responses should be brought to Crystal Park 5, 2451  
Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

9/08/2004



**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
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